appropriate procedure is to request interference.

Argument

Applicant will first address the issue of the 131 affidavit. (Issue C of the summary) Respectfully the Examiner is believed to be improperly applying the rules for determining when two claims are considered to claim the same invention for interference purposes and, ergo, for the appropriateness of a §131 affidavit.

As will be discussed hereafter, it is applicant's contention that Eggenmuller does not teach the features which the Examiner attributes to that disclosure. Applicant nevertheless wishes to point out that applicant's 131 Affidavit swears back of the Meyer patent as well as the Cullen patent. This was not previously pointed out as the Eggenmuller/Meyer structure was believed to be clearly distinguished. Applicant here requests consideration of the 131 Affidavit as it applies to Meyer and requests withdrawal of the Meyer reference as prior art.

The Claimed Invention of the Cullen Patent

The last element of the Cullen patent is set forth as follows:

> "said means for positioning the elongated pipe means in the compost material including means for positioning the pipe means in a horizontal position, a reel means positioned on said

wheeled frame means outwardly of said tunnel means, said reel means having the elongated pipe means wound thereon, and a guide means extending between said reel means and the interior of said tunnel means for guiding the pipe means from said reel means into the interior of said tunnel means."

The above element directed to a "reel means" is but one of at least seven elements listed in the Cullen claim. There is no equivalent limitation in any of the claims pending in applicant's application. Applicant's Claims 7 and 8 included the element of a conduit-holding reel mounted to the machine. However, Claims 7 and 8 have been cancelled from the present application and have been filed in a divisional application. A Request for Interference with the Cullen patent has been made in that case.

As recited by the Examiner, the test for determining whether two claims are drawn to the same invention "is analogous to that applied for double patenting;". The CAFC discussed this double patenting issue at length in General Foods v. Studiengesellschaft Kohle MbH, 972 F2d 1272 (Fed. Circ. 1992):

"Another way of stating the legal truism is that patent claims, being definitions which must be read *as a whole*, do not "claim" or cover

or protect all that their words may *disclose*. Even though the claims to the A-B-C combination of steps contains a detailed description of step A, that does not give the patentee any patent right in step A and it is legally incorrect to say that step A is "patented."

"These legal rules about construing claims are repeated here because the law of double patenting is concerned *only* with what patents *claim*. "Double patenting," therefore, involves an inquiry into what, if anything, has been claimed twice." (Pages 1274-1275)

"Claim 1 of the '619 patent, relied on to show double patenting, defines a *9-step process* of 'obtaining caffeine from green coffee.' Anything less than a process with all 9 steps is not what is claimed, and is, therefore, not patented. Claims must be read as a whole in analyzing a claim of double patenting." (Page 1278)

"Under an obviousness-type double patenting analysis, neither *claimed* process is a mere

obvious variation of the other. No other kind of 'double patenting' is recognized, so there is no double patenting." (Page 1278)

"Double patenting law principles extend to merely obvious variants of *what has been patented*. Step one of the analysis is to determine what that is. Claims are the determinants." (Page 1280)

"it is important to bear in mind that comparison can be made only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim *defines* and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference." (Page 1280)

"This concept violates the fundamental rule of claim construction, that what is claimed is what is *defined by the claim taken as a whole*, every claim limitation (here each step) being material. What is patented by Claim 1 of '619 is a *9-step caffeine recovery process*, nothing more and

nothing less." (Page 1280)

"Our precedent makes clear that the *disclosure* of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure is found in the claims*." (Page 1281)

"('We are not here concerned with what one skilled in the art would be aware [of] from *reading* the claims but with *what inventions the claims define*.')" (Page 1282)

Applicant respectfully submits that the Cullen patent claim includes as one of its elements a structure which has no equivalent in any of the claims of record. Cullen claims a reel means; positioned on said wheeled frame means; outwardly of said tunnel means; the pipe means wound on the reel means; and a guide extending from the reel means to the interior of said tunnel means.

Cullen clearly claims a different invention as determined by the test for double patenting.

Applicant also points out that the Examiner in the prosecution of the Cullen patent rejected claims that did not include the "reel means" limitation and indicated allowance of the dependent claim

which included the reel means limitation. The dependent claim written in independent form was allowed and is the patent claim. The present Examiner indicated allowance of applicant's Claims 7 and 8 in Paper No. 3 while rejecting the parent claims. Obviously in both cases the reel structure of the dependent claims was considered to render the total claim patentably distinct from its parent claim.

The Examiner is respectfully requested to reverse his position and to accept the 131 Affidavit for purposes of removing both the Meyer reference and the Cullen reference as prior art.

Concerning Issues A and B of the Summary

The removal of Meyer and Cullen as prior art is believed to overcome all of the Examiner's prior art rejections. Nevertheless, applicant here responds to the Examiner's contention that "the claimed method (of Claims 1-5) is substantially shown in Figs. 10-13 of Eggenmuller with the exception of providing perforated conduit which can be connected to a media source at the open end of the bag."

The conduit 32 ("channel 32") is shown only in Fig. 4. Note that the channel 32 is installed on a concrete plate 12. The reference number 12 is not shown in the cross sectional view of Fig. 4 but it is in the end view of Fig. 3. The concrete plate 12 is referred to at Col. 5, line 33.

Note further that the process of Figs. 1-5 does not even insert the material in a bag. The feed material is pressed into a form and placed on the solid ground or plate 12. A foil sheet 13 is drawn over the formed feed material but the foil 13 is not a bag. Note for example the flared sides of foil 13 anchored to the ground in Fig. 4.

The teaching with respect to channel 32, as to one form, is that a floor is formed and the channel 32 is "permanently installed in the bottom", i.e., the concrete plate 12. As an alternate form of channel 32, Eggenmuller states that the channel may be "produced during the pressing process by suitable means." What this has to mean, as can be best determined, is that the machine carries something like a slidable forming channel and the feed material is formed around the channel and retains that form as the machine draws the forming channel along the ground. Thus, assuming the feed material <u>as formed</u> retains the formed shape unsupported, the channel will be retained. That may be the case for silage but not for grain or compost.

Clearly the embodiment of Figs. 1-4 do not show or teach filling a bag or directing a conduit from the machine and through the open end of the bag.

The embodiment of Figs. 10-13 disclose a bag (plastic tube 49) but there is no suggestion for inserting a channel through the bag

other than "to form an air channel 56 in the mass of food during pressing thereof". (Col. 7, lines 64-66) This again requires something like a slidable form, e.g., a channel in the top of chamber 3, against which the feed material is pressed in the pressing operation.

Certainly channel 32 which is permanently installed on the concrete floor of the embodiment of Figs. 1-4 cannot be considered applicable to the embodiment of Figs. 10-13. (Figs. 1-4 is not a bag, the floor forming the bottom support. Figs. 10-13 is an enclosed tube.) There is no suggestion in Eggenmuller for providing a conduit that is fed into an enclosure, i.e., a bag or tube during the process of filling the bag or tube. A formed channel pressed into the feed material is not a conduit. There is no teaching as to how a "conduit" would be inserted into a bag.

At page 6 of the Office Action, the Examiner contends that channel 32 of Eggenmuller is being directed from the machine and through the open end of the bag into the contents of the bag as the bag is being filled with contents. Channel 32 is either permanently installed on the solid floor or it is formed in the material of the bag. In either instance, there is not a conduit being directed into a bag during filling.

In summary, both Meyer and Cullen are removed as prior art references by reason of Applicant's §131 Affidavit. (Note that

applicant encloses replacement Exhibits A_2 and C which are merely clearer copies of the originals.)

The claims of record are all believed allowable and formal allowance is respectfully requested. Should the Examiner disagree with the above or should there remain other issues not yet resolved, a telephone interview is respectfully requested.

Respectfully submitted,

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Reg. No. 20,994

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as First Class Mail, in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date indicated below.

Date June 9, 1995

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